

Appln. No. 10/779,661
Reply to Office Action of 07/07/05.

REMARKS

Favorable reconsideration of this application in view of the following remarks is respectfully requested.

Claims 14, 15, 17, and 18 are presented for examination on this application. Claims 16 and 19 are herein cancelled without prejudice or disclaimer and Claims 1-13 have been previously cancelled without prejudice or disclaimer. Claim 14 has been amended to include most of the subject matter of canceled Claim 16 and, accordingly, no issue of new matter is presented.

As the cancellation of Claim 19 clearly results in reduced issues for appeal and as the amendment to Claim 14 to include the subject matter of Claim 16 along with the cancellation of Claim 16 is equivalent to rewriting Claim 16 in independent form and canceling Claim 14, entry of the present amendment is believed to be clearly proper under 37 CFR § 1.116.

The outstanding Action presented an objection to the drawings, a rejection of Claim 14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Iwata et al. (U.S. Patent No. 5,880,500, Iwata), a rejection of Claims 14-18 as being unpatentable over the asserted admitted prior art illustrated in Application Figures 1-8 in view of Iwata, and a rejection of Claim 19 as being unpatentable over the asserted admitted prior art illustrated in Application Figures 1-8 in view of Gardner (U.S. Patent No. 6,200,865).

Turning first to the objection to the drawings, it is noted that the PTO has no authority to require that the specific label “prior art” be attached to anything simply because the PTO alleges it to be “old.” In this regard, MPEP § 608.02 (g) is not a statute, it is not a “rule” and it does not

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list any case law as requiring the use of the legend “prior art” to annotate any drawing. To the extent that MPEP § 608.02 (g) serves as a guideline, it is not a mandatory guide line as the term “Prior Art” is clearly set forth as a non-binding example- in terms of noting that a “legend such as ‘Prior Art’” (emphasis added) can be used. This statement is clearly different than the statement that the outstanding Action appears to assume to be present as to --a legend admitting the showing to be “Prior Art” must appear--.

In any event, after a careful review of the status of Figures 1-8, Applicants have concluded that only Figures 1-6 can be reasonably characterized as illustrating actual “Prior Art” and, accordingly, have changed the legend on these Figures to read “Prior Art.” In this regard, U.S. Patent No. 5,391,510 to Hsu et al. and U.S. Patent No. 5,960,270 to Misra et al. are noted as exemplary.

However, Figures 7 and 8 show the work of only the present inventors in terms of their estimations of problems that can arise when high dielectric constant insulating films, like the Ta₂O₃ film noted at page 4, line 18-page 5, line 23 of the specification, for example are used instead of the films used in the original “Prior Art” devices. This discussion of potential problems recognized by the present inventors as to modifying existing devices to incorporate high dielectric constant insulating films, like the Ta₂O₃ film, does not qualify as “Prior Art” simply because of where in the specification it is discussed. Accordingly, the legend “Background Art” need not be changed as to these Figures and the requirement to do so is traversed. Withdrawal of this requirement is respectfully requested.

The rejection of Claim 14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Iwata is now clearly moot as most

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of the subject matter of Claim 16 (requiring the gate insulating film to contain one of Ta₂O₅, Al₂O₃, BaSrTiO₃, Zr oxide Hf oxide, Sc oxide, Y oxide, and Ti oxide) is now incorporated into Claim 14. In addition, the outstanding Action acknowledges that Iwata contains no such teachings or suggestions as to the rejection of Claim 16 at page 5 of the outstanding Action. Accordingly, withdrawal of this rejection of Claim 14 is clearly in order.

The rejection of Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over the asserted admitted prior art illustrated in Application Figures 1-8 in view of Gardner, this rejection is also moot as this Claim has been canceled.

Turning to the rejection of Claims 14-18 as being unpatentable over the asserted admitted prior art illustrated in Application Figures 1-8 in view of Iwata, this rejection is believed to be in error as to assuming that the work of the present inventors illustrated in Figures 7 and 8 can be simply assumed to be "Prior Art" as to the subject matter of Claim 16 that has been incorporated into Claim 14.

In this last regard, and as noted above, the PTO is clearly erroneously inferring an admission that it was known to use the listed materials as the materials for a gate insulating film in the arrangements illustrated as to Figures 7 and 8 when no such admission has been made. Accordingly, the rejection of Claims 14-18 as being unpatentable over the asserted admitted prior art illustrated in Application Figures 1-8 in view of Iwata is traversed as the relied upon Figures 7 and 8 and the descriptions appearing at page 4, line 23-page 5, line 23 are not admitted "Prior Art." As Iwata taken alone cannot be said to teach or suggest the subject matter of amended Claim 14, much less that of Claims 15, 17, and 18 that depend from Claim 14, withdrawal of this rejection as applied to amended Claims 14, 15, 17, and 18 is submitted to be

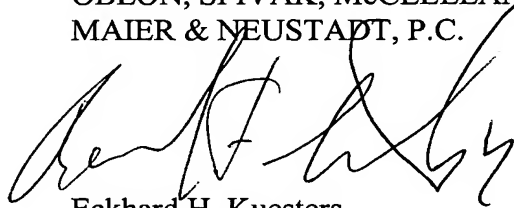
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in order.

Accordingly, as no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to this effect is earnestly and respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Eckhard H. Kuesters', is written over the printed name and title.

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